

Amendment Under 37 C.F.R. § 1.116
US Appln No. 10/092,296

Docket No. Q68841

AMENDMENTS TO THE DRAWINGS

The attached proposed drawing correction includes the following changes:

In Fig. 2A the label “PROGROAM INFORMATION n” has been replaced with the label
“PROGRAM INFORMATION n”

Attachment:

Annotated Sheet

REMARKS

Applicants thank the Examiner for acknowledging that replacement drawings for Figures 1 and 3 were received on February 14, 2005, and are acceptable.

Status of the Application

Claims 1-13 are all the claims pending in the Application. Claims 4-13 have been rejected. Claims 1-3 have been allowed

Drawings Objection

The Examiner has objected to informalities in the drawings. These informalities have been addressed by amendment herein. Thus, withdrawal of these objections is respectfully requested.

Claim Objections

The Examiner has objected to informalities in claim 10. These informalities have been addressed by amendment herein. Thus, withdrawal of these objections is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claim 10 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Applicants submit that the amendments to the claim overcome the rejection. Also, Applicants submit that the illustrative, non-limiting embodiments disclosed in the specification fully support the claim limitations.

For example, as shown in Fig. 3, a controller (*e.g.*, a microcomputer 31) judges if program information (*e.g.*, a file folder) is copied on a second recording medium (*e.g.*, a hard disk B) by determining if the program information, which is coincident with read TOC information, exists in an area B1 of the second recording medium B. (Operation S34). Also, if the program information is not copied on the second recording medium B, the controller 31 reproduces the program information from a first recording medium (*e.g.*, an optical disc 12) via a first reproducer 2 and copies the information on the area B1 of the second recording medium B. (Operation S38; page 17, lines 7-12). Since the controller 31 performs operation S38 after operation S34, the specification clearly discloses that the controller 31 judges if the program information is copied onto the second recording medium B prior to reproducing the program information via the first reproducer 2.

In light of the discussion above, Applicants submit that claim 10 satisfies the requirements of 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 10 under 35 U.S.C. § 112, second paragraph, for being indefinite. Applicants submit that the amendments to the claims overcome the rejection.

Prior Art Rejections

102 Rejections

The Examiner has rejected claims 4, 5, and 7-11 under 35 U.S.C. § 102(e) as being anticipated by *Lee* (PN 6,292,440). Applicants respectfully traverse this rejection.

For example, claim 4 judges if program information is copied onto a second recording medium when the program information recorded on a first recording medium is reproduced. The Examiner alleges that Lee inherently discloses these features, but Applicants respectfully disagree.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) and MPEP 2112 (IV). In other words, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added; citations omitted) and MPEP 2112 (IV).

In rejecting claim 4, the Examiner has not provided any facts or technical reasoning to support his contention that the claimed features necessarily are present in the Lee method. For example, in Lee, the device could possibly judge if the program information is copied onto a second recording medium before the program information recorded on a first recording medium is reproduced. Therefore, Lee does not inherently disclose the above feature of claim 4.

Also, claim 4 states that the reproducing of the program information recorded on the first recording medium is stopped and that copied program information is reproduced if it is judged that the program information is copied. The portions of Lee that the Examiner alleges suggests these features merely disclose that the steps followed depend on the type of data detected. Furthermore, no portion of Lee teaches or suggests stopping the reproduction of the program information as recited in claim 4.

In light of the discussions above, claim 4 is patentable at least for these reasons.

Regarding claim 5, the claim comprises a controller that controls a first reproducer not to reproduce program information on a first recording medium and controls a second reproducer to reproduce the program information on the second recording medium if the second recording medium contains the program information. The Examiner alleges that Lee inherently discloses these features, but Applicants respectfully disagree.

As previously stated in the Response to the Office Action dated February 14, 2005, Lee reproduces program information only based on type of data on the first recording medium. On the other hand, in claim 5, information is not reproduced from the first recording medium and is reproduced from the second recording medium if the second recording medium contains the program information.

Since Lee does not disclose these features, Applicants submit that claim 5 is patentable. Also, Applicants submit that these features are not inherent for reasons that are similar to the reasons presented above in conjunction with claim 4.

Since claims 7-9 depend on claim 5, they are patentable at least by virtue of their dependency.

Claim 10 states that the controller controls the first reproducer to reproduce the program information being copied from the first recording medium onto the second recording medium when the controller judges that the program information is not copied on the second recording medium. Applicants submit that Lee does not teach these features of claim 10 for reasons that are similar to why it does not teach the features discussed above in conjunction with claim 5.

Since claim 11 contains features that are analogous to the features recited in claim 5, Applicants submit that claim 10 is patentable for reasons that are analogous to the reasons why claim 5 is patentable.

103 Rejections

The Examiner has rejected claims 6, 12, and 13 under 35 U.S.C. § 102(e) as being unpatentable over *Lee* (PN 6,292,440) in view of *Hira* (PN 5,392,264). Applicants respectfully traverse this rejection.

Since claims 6 and 12 depend upon claim 5 and 11, respectively, and since *Hira* does not cure the deficient teachings of *Lee* with respect to claims 5 and 11, Applicants submit that claims 6 and 12 are patentable at least by virtue of their dependency.

Regarding claim 13, the claim states that, if a control circuit determines that program information has been copied to a second recording medium, the control circuit controls a first reproduction circuit to not reproduce the program information from the first recording medium and controls the second reproduction circuit to reproduce the program information from the

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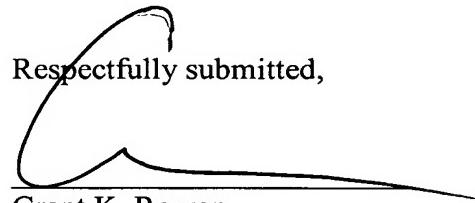
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second recording medium. Since such feature are similar to the features recited in claim 5, Applicants submit that claim 13 is patentable for similar reasons.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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